



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,051	05/10/2001	Eduardo J. Jimenez	P 278455 HT-3085REG	3787

909 7590 11/14/2002
PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

COURSON, TANIA C

ART UNIT PAPER NUMBER

2859

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,051

Applicant(s)

JIMENEZ ET AL.

Examiner

Tania C. Courson

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings filed on September 10, 2001 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bearinger in view of Jewell.

Bearinger discloses a straight edge holding device comprising:

- a) an elongated finger-resting surface (Fig. 1, flange 4);
- b) an elongated upstanding section projecting upwardly from said finger-resting surface (Fig. 1, retainer 22);
- c) an elongated scale-supporting section coupled to and extending along said upstanding section (Fig. 1, flange 6) with said upstanding section being positioned between said first scale-supporting section and said finger-resting surface (Fig. 1),

- ... said scale-supporting section being inclined with respect to a guiding device supporting surface (Fig. 1);
- d) an elongated first scale having an upper surface (Fig. 1, flat upper surface 14), said upper surface having first indicia to indicate predetermined lengths along said first scale (Fig. 1);
- e) said finger-resting surface permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement by said upstanding section during movement of the implement along said guiding device adjacent said first scale (Fig. 1);
- f) wherein said finger-resting surface is substantially flat (Fig. 1);
- g) a substantially flat contact surface (Fig. 1, flat supporting surface 8) positioned beneath said finger-resting surface, said upstanding section, and said scale supporting section to permit smooth application of said guiding device on the working surface (Fig. 3);
- h) wherein said contact surface includes an elongated recess (Fig. 3, recess 10);
- i) wherein said guiding device has a generally T-shaped cross-section (Fig. 3).

Bearinger does not disclose an elongated first scale made of metal and having a lower surface, said lower surface being rigidly and unreleasably attached to said first scale-supporting section, said first scale having a non-metallic coating on said upper surface and a contact surface including a second indicia indicating predetermined lengths along said contact surface and said second indicia is printing on said contact surface.

With respect to an elongated first scale made of metal and having a lower surface, said lower surface being rigidly and unreleasably attached to said first scale-supporting section, said first scale having a non-metallic coating on said upper surface, a contact surface including a second indicia indicating predetermined lengths along said contact surface and said second indicia is printing on said contact surface, Jewell teaches a ruler that consists of an elongated first scale made of metal (column 1, lines 30-33) and having a lower surface, said lower surface (column 1, lines 30-33) being rigidly and unreleasably attached to said first scale-supporting section, said first scale has a non-metallic coating on said upper surface (column 1, lines 30-33), a contact surface (Fig. 2) including a second indicia (Fig. 2) indicating predetermined lengths along said contact surface and said second indicia is printing on said contact surface (column 1, lines 45-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the straight edge holding device of Bearinger, so as to include a contact surface having a second indicia, as taught by Jewell, so as to provide additional measuring units so as to increase the capacity of measurements during use of the device.

4. Claims 3-4 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bearinger and Jewell, as applied to claims 1, 2, 5-9 and 12 as stated above, and further in view of Syed.

Bearinger and Jewell disclose a straight edge holding device as stated above in paragraph

2. They further disclose:

Art Unit: 2859

- a) wherein said finger-resting surface, said upstanding section, and said scale supporting section are integrally formed as a unitary, one-piece element (Fig. 3);
- b) wherein said upstanding section is a wall having a first side facing said first scale and a second side (Fig. 3, side walls 24 and 26) facing said finger-resting surface, with said first side being inclined with respect to said scale-supporting section (Fig. 3), and;

Bearinger and Jewell do not disclose a finger-resting surface, an upstanding section, and a scale supporting section formed of plastic and a second side including a plurality of ribs.

Regarding claim 4: Bearinger and Jewell disclose the finger-resting surface, the upstanding section, and the scale supporting section of a durable (column 1, lines 57-62) material. The particular type of material used to make the finger-resting surface, the upstanding section, and the scale supporting section, absent any criticality, is only considered to be the use of a “preferred” or “optimum” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Art Unit: 2859

With respect to a second side including a plurality of ribs, Syed teaches a ruler that consists of a second side including a plurality of ribs (column 3, lines 4-6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the straight edge holding device of Bearinger and Jewell, so as to include a second side including a plurality of ribs, as taught by Syed, so as to provide a good grip during use of the device.

5. Claim 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bearinger in view of Jewell.

Bearinger discloses a straight edge holding device comprising:

- a) an elongated first portion (Fig. 1, flange 4) having a finger-resting surface (Fig. 1) and a bottom surface (Fig. 3) opposite to said finger-resting surface;
- b) an elongated second portion (Fig. 1) extending along said first portion, said second portion having an upstanding section (Fig. 1, retainer 22) and an inclined scale-supporting section (Fig. 1, flange 6), said upstanding section projecting upwardly from said finger-resting surface and having an uppermost free end (Fig. 1), said upstanding section being positioned between said scale-supporting section and said first portions (Fig. 3), said first and second portions having a generally T-shaped cross-section (Fig. 3);
- c) an elongated first scale (Fig. 1), an upper surface (Fig. 1, flat upper surface 14) having first indicia to indicate predetermined lengths along said first scale (Fig. 1), said upper surface of said first scale being inclined with respect to the working

surface such that said innermost edge of said first scale is further from the working surface than said outermost edge of said first scale (Fig. 1), an innermost edge positioned closest to said free end of said upstanding section, and an outmost edge remote from said innermost edge (Fig. 1);

- d) said bottom surface of said first portion being configured to be placed against a substantially flat working surface (Fig. 1, flat supporting surface 8);
- e) said finger-resting surface permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement by said upstanding section during movement of the implement along said guiding device, adjacent said first scale (Fig. 1);
- f) each of said finger-resting surface and said first bottom surface of said first portion is substantially flat (Fig. 1), and said finger-resting surface is substantially parallel to said first bottom surface (Fig. 3);
- g) wherein said first portion and said second portion are integrally formed as a unitary, one-piece element (Fig. 3);
- h) said upstanding section is a wall (Fig. 3) having a first side facing said first scale and a second side (Fig. 3, side walls 24 and 26) facing said finger-resting surface, with said first side being inclined with respect to said scale-supporting section (Fig. 3);
- i) said upstanding section includes means for gripping said upstanding section by fingers of a user of said guiding device (Fig. 1).

Art Unit: 2859

Bearinger does not disclose a first portion and a second portion formed of plastic, an elongated first scale made of metal having a lower surface rigidly and unreleasably attached to said scale-supporting section, and a bottom surface including a second indicia indicating predetermined lengths along a contact surface.

Regarding claim 16: Bearinger discloses the first portion and second portion of a durable (column 1, lines 57-62) material. The particular type of material used to make the finger-resting surface, the upstanding section, and the scale supporting section, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

With respect to an elongated first scale made of metal having a lower surface rigidly and unreleasably attached to said scale-supporting section, and a bottom surface including a second indicia indicating predetermined lengths along a contact surface, Jewell teaches a ruler that consists of an elongated first scale made of metal (column 1, lines 30-33) having a lower surface rigidly and unreleasably attached to said scale-supporting section (column 1, lines 30-33), and a bottom surface (Fig. 2) including a second indicia indicating predetermined lengths along a

Art Unit: 2859

contact surface (column 1, lines 45-47). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the straight edge holding device of Bearinger, so as to include a bottom surface including a second indicia, as taught by Jewell, so as to provide additional measuring units so as to increase the capacity of measurements during use of the device.

6. Claims 1 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syed in view of Jewell.

Syed discloses in Figures 6-8, a ruler comprising:

- a) an elongated finger-resting surface (Fig. 8);
- b) an elongated upstanding section projecting upwardly from said finger-resting surface (Fig. 8, roller 56);
- c) an elongated scale-supporting section coupled to and extending along said upstanding section (Fig. 8, ruler 50) with said upstanding section being positioned between said first scale-supporting section and said finger-resting surface (Fig. 8), said scale-supporting section being inclined with respect to a guiding device supporting surface (Fig. 8);
- d) an elongated first scale having a lower surface (Fig. 8) and an upper surface (Fig. 8), said lower surface being rigidly and unreleasably attached to said first scale-supporting section (Fig. 8) and said upper surface having first indicia to indicate predetermined lengths along said first scale (Fig. 8);

Art Unit: 2859

- e) said finger-resting surface permitting fingers of a user gripping said guiding device to be positioned on said finger-resting surface while being protected from an implement by said upstanding section during movement of the implement along said guiding device adjacent said first scale (Fig. 8);
- f) wherein said upstanding section has a closed free end that contains no upwardly projecting openings (Fig. 8).

Syed does not disclose an elongated first scale made of metal.

Jewell teaches a ruler that consists of an elongated first scale made of metal (column 1, lines 30-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the ruler of Syed, so as to include an elongated first scale made of metal, as taught by Jewell, so as to provide a stronger material in order to maintain straightness during use of the device.

Response to Arguments

7. Applicant's argument's, with respect to the claim rejections under 35 U.S.C. 103, filed August 28, 2002 have been fully considered but they are not persuasive

8. In response to the applicant's argument that Jewell fails to disclose a ruler with a scale having a "lower surface being rigidly and unreleasably attached to said scale-supporting section,

Art Unit: 2859

such is moot, because “unreleasably attached” is sufficiently broad enough to embrace constructions united by such means as fastening and welding.

9. In response to the applicant’s argument that Bearinger already has two scales, it is Jewell’s disclosure, not Bearinger’s, of having scales on both the upper and lower surfaces that is being taught.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. In response to the applicant’s argument that Bearinger’s paper holder would be destroyed, such is moot, having a scale on the lower surface of Bearinger does not destroy the reference, it only adds to the number of scales available for one’s use, one could still utilize the paper holder of Bearinger and its intended uses even with a scale on the lower surface.

12. In response to the applicant’s argument that Bearinger fails to disclose “said finger-resting surface is substantially parallel to said first bottom surface”, such is moot, “substantially

Art Unit: 2859

parallel” is a broad term which may read upon Bearinger’s disclosure of “the upper surfaces which are inclined slightly” (col. 2, lines 15-16).

13. In response to the applicant’s argument that Bearinger fails to disclose “said upstanding section includes means for gripping said upstanding section by fingers of a user of said guiding device”, such is moot, since, as the applicant points out, claim 20 invokes a means-plus-function limitation which includes the structure disclosed in the specification as performing the function and **its equivalent**, which is shown in Figure 1.

14. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., ribs) are not recited in the rejected claim 20. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2859

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
November 12, 2002